



UNITED STATES PATENT AND TRADEMARK OFFICE

#10/Election
4/23/02

PATENT

Hawkins

In re the Application of:

Manoj Ramprasad Shah et al.

Serial No.: 09/749,197

Filed: December 27, 2000

For: A POWER GENERATOR

Atty. Docket No.: 11777.00023

Group Art Unit: 2834

Examiner: P. Cuevas

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants received on January 31, 2002, a Restriction Requirement mailed December 11, 2001. A Request to Restart the Period for Response was filed via fax on February 4, 2002 (Tab A: copy of Request with fax confirmation). In accordance with Memorandum I issued February 15, 2002, from the Deputy Commissioner for Patent Examination Policy (Tab B: copy of Memorandum I), applicants submit that the period for response should run from the receipt date of the Restriction Requirement, January 31, 2002, making this Response timely with a two-month extension of time filed herewith.

In response to the Requirement, applicants hereby elect for prosecution at this time Group I, claims 1-12 and 20.

This election is made with traverse. Applicants submit that the subject matter of the three identified groups are sufficiently related that a thorough search for one group would encompass a search for the subject matter of the other groups. This is especially true in light of the fact that the Examiner classifies all three groups of claims in class 310. The subclasses are 190, 216 and 217. Applicants submit that numerous issued patents indicate a classification and a field of search that encompass the subclasses that the Examiner cites for restriction. (See for example, US 6,225,725 classified in 310/216 & 217; US 6,265,805 and US 6,246,142 classified

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and searched in 310/216 & 217; US 6,255,753 classified in 310/190 & 216; US 5,969,457 and US 5,650,680 classified and searched in 310/190 & 216).

Thus it is respectfully submitted that the search and examination of all of the claims could be made without serious burden. *See* MPEP §803 in which it is stated that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits.” It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to applicants, and duplicative examination by the Patent Office.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: 
Patricia E. Hong
Registration No. 34,373

Dated: April 11, 2002

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To: Examiner P. Cuevas	FROM: Patricia E. Hong
COMPANY: United States Patent & Trademark Office	DATE: February 4, 2002
FAX NUMBER: 703/305-1341	TOTAL No. OF PAGES: <u>45</u>
RE:	OUR REFERENCE No.: 011777.00023

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Manoj Ramprasad Shad et al.

Serial No.: 09/749,197

Filed: December 27, 2000

For: A POWER GENERATOR

Atty. Docket No.: 11777.00023

Group Art Unit: 2834

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REQUEST FOR RESTARTING PERIOD FOR RESPONSE

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In accordance with MPEP 710.06, applicants respectfully request that the office restart the period for response for the Office Action/Restriction Requirement mailed December 11, 2001 in the above-referenced application. Applicants recently received the Office Action/Restriction Requirement on January 31, 2002. Applicants enclose herewith a copy of the cover page of the Office Action/Restriction Requirement mailed December 11, 2001. Shown on the cover page is a date stamp evidencing receipt of the communication by applicants' representatives at Banner & Witcoff, LTD on January 31, 2002. It is the practice at Banner & Witcoff, LTD to date stamp all mail upon receipt.

In view of the foregoing, applicants submit restarting the period for response is appropriate due to the late receipt of the Office Action/Restriction Requirement. Should further information to satisfy this request be necessary, please contact the

undersigned at the number below. No fee is believed to be due with this filing. Please charge any fees associated with this filing to deposit account no. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By:



Patricia E. Hong
Registration No. 34,373

Dated: February 4, 2002

Banner & Witcoff, Ltd.
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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,197	12/27/2000	Manoj Ramprasad Shah	11777.00023	5274

28480 7590 12/11/2001
BANNER & WITCOFF, LTD.
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JAN 31 2002

BANNER & WITCOFF LTD.

EXAMINER

CUEVAS, PEDRO J

ART UNIT	PAPER NUMBER
2834	

DATE MAILED: 12/11/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

11777.00023
DOCKETED
Request for Restr.:
JAN 31 2002
14 FC 2002

DOCKETED
Restriction
JAN 31 2002 A/E
11 FC 2002 A/E
11 JE 2002: Last Day

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I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office

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H. Laura McPherson

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Request for Restarting Period for Response

Burden Hour Statement: This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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FACSIMILE TRANSMITTAL SHEET

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From:
Patricia E. Hong

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United States Patent & Trademark Office

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February 4, 2002

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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MEMORANDUM - I

DATE: February 15, 2002

TO: Patent Examining Corps Directors

Stephen G. Kunin

FROM: Stephen G. Kunin

Deputy Commissioner for Patent Examination Policy

**SUBJECT: Resetting Period for Reply and Remailing Office Communications
when Outgoing Office Mail is Delayed**

This memorandum addresses Office relief procedures for mail delays involving outgoing Office correspondence mailed on or after October 13, 2001 and before January 2, 2002, including:

- (A) Petitions to reset a time period set in an Office action (or notice) where delivery to applicant(s) has been delayed; and
- (B) Requests to remail an Office action (or notice) that has been mailed by the Office but not yet received by applicant(s).

The memorandum also includes four attachments:

- I: Template Decision for Granting Petition to Reset Period for Reply
- II: Template Decision for Granting Petition to Remail an Office action and Restart Period for Reply
- III: Template Decision for Granting Petition to Withdraw Holding of Abandonment
- IV: PALM Procedures for Resetting and Restarting Reply Period

In view of the recent delays in the USPS delivery of mail from the Office to applicants, many applicants are requesting the Office to reset the time period for reply so that the starting date is changed from the Office mail date to the date of actual receipt of the Office action (or notice). Many applicants are also requesting the Office to remail actions (or notices) that they have not yet received even though the applicants know that they were mailed by the Office two or more weeks previously. These issues will be addressed in this memo. Memorandum II addresses treatment of:

- (1) replies filed by *Pro Se* applicants without the benefit of 37 CFR 1.8 or 1.10, and
- (2) after-final amendments that are untimely due to incoming mail delays.

Memorandum I – Resetting Period for Reply and Remailing Office Action
February 14, 2002

I. Procedures to reset a time period for reply so that it starts on the date that applicant(s) actually received the Office action (or notice) instead of the Office's mail date.

The Office's procedure for treating a petition to reset a time period set in an action (or notice) because delivery of the action (or notice) has been delayed by the USPS is set forth in MPEP 710.06. These procedures were established to: (a) provide a complete public record of why a time period was reset; (b) insist on the prompt submission of such petitions; and (c) make it clear that applicant(s) should set forth adequate justification for requesting the resetting of the time period for reply, to avoid frivolous requests.

As the Office is aware that USPS delivery of correspondence to certain locations (e.g., the District of Columbia) has been delayed, **the evidence to establish late receipt of an Office action (or notice) ordinarily required in MPEP 710.06 need not be insisted upon** for the circumstances noted in this memorandum. For Office actions (or notices) that were mailed between October 13, 2001 and January 2, 2002, the Office should grant a petition to reset a time period for reply if the following requirements are met:

- A) **Separate Petition:** In order to provide a complete file history, a separate petition must be filed for each application for which a reset time period is requested;
- B) **Timeliness:** A written petition must be filed within two weeks of actual receipt of the action/notice;
- C) **Significant Delay:** More than a month of a two or three month time period set for reply must have elapsed, or more than two weeks of a month/30 day time period set for reply must have elapsed (e.g., a written restriction, or a notice of non-compliant amendment);
- D) **Evidence:** In general, because of the recent problem of USPS mail delays, the requisite evidence is considered met by the statement in (E) below;
- E) **Statement:** There must be a clear statement that the action/notice was received on the date indicated, and a request that the period for reply be reset as of the date of receipt; and
- F) **Signature:** The petition must be signed by applicant(s) or a registered practitioner.

See Attachment I for a template decision granting a petition to reset period for reply. A request to reset a time period for reply will be treated as a petition filed under 37 CFR 1.181 to reset a time period for reply. A petition fee is not required for a petition filed under 37 CFR 1.181. Each petition will be given a paper number, and entered into the file wrapper. In response to a proper petition by applicant(s), the Office must notify applicant(s) that the petition was granted and that the time period has been reset to begin on the receipt date specified by applicant(s). The original Office action (or notice) need not be mailed again. If the petition is not grantable because the requirements noted above are not met, the petition should be dismissed. The Office will notify applicant that the petition is dismissed and cite the reasons why. The notification/dismissal will be given a paper number and made of record in the application file.

Memorandum I – Resetting Period for Reply and Remailing Office Action
February 14, 2002

The decision may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record, but it must also be mailed to the correspondence address.

Advisory Actions: A petition to reset a time period for reply because an advisory action was delayed in delivery or mailed late because of the delay in delivery of the after final amendment should not be granted. See MPEP 714.13. In the circumstance where the advisory action relates to an after-final reply filed within two months of the final rejection and receipt of the advisory action was delayed, please contact an advisor in the Office of Patent Legal Administration at (703) 308-6906.

PALM Processing Procedures

When resetting the period for reply to an Office action, the Technology Centers **will not** change the date of mailing of the Office action. Instead, the Technology Centers will follow the procedure in Attachment IV, section I.

II. Procedures to remail, or fax, an Office action (or notice) that was previously mailed by the Office but has not yet been received by applicant(s).

Many applicants, aware of the delay in delivery of Office communications to certain locations, are checking on their pending applications via private PAIR, or otherwise, to see if an Office action (or notice) has been sent out. If an Office action has been mailed, and applicants have not yet received it, they are now requesting that the Office remail it or send them a facsimile copy of the communication. Before complying with the request, however, it is important to determine if applicant(s) (an inventor(s) or an attorney or agent of record) is requesting:

- (A) a courtesy copy of the Office communication (see subsection A below); or
- (B) a remailing of the Office communication with a restarting of the period for reply (see subsections B and C below).

A. If Courtesy Copy is Requested

If applicant does not request that the Office action be remailed (or the period for reply be reset) and instead requests a courtesy copy, it is appropriate to send a facsimile copy of the Office communication to a facsimile number specified by an applicant(s) or by an attorney or agent of record. If someone other than an applicant(s) or an attorney or agent of record calls requesting a courtesy copy, the Office should offer to send a courtesy copy to the applicant(s) or the attorney or agent of record at a facsimile number specified in a paper in the application file wrapper signed by the applicant(s) or an attorney or agent of record. If there is no such fax number specified in the file wrapper, the applicant(s) or the attorney or agent of record should fax in a signed request for a duplicate paper, and the request should be entered into the application file wrapper. An interview summary should also be mailed to document when the courtesy copy was faxed.

B. If Remailing with Restarting of Reply Period is Requested Within the Maximum Extendable Period for Reply

If applicant(s) requests that the Office action (or notice) be remailed with a new time period and either the original period for reply has not expired or an extension of time is still available, the request will be treated as a petition under 37 CFR 1.181. The petition should be decided by the Office that mailed the Office action (or notice). The petition should be granted if the following requirements are met:

A) **Statement:** There must be a clear statement that the Office communication was not received;

B) **Evidence:**

- i. A copy of the docket record where the non-received Office action (or notice) would have been entered had it been received and docketed is ordinarily required to be attached and referenced in practitioner's statement.
- ii. Acceptable alternative: If a practitioner states that a significant amount of correspondence mailed by the Office between October 13, 2001 and January 2, 2002 has not been received, and provides the requisite statement in (A) above, then the evidence set forth in (B)(i) above would not be needed.
- iii. Alternative for Pro se applicant(s): If a *pro se* applicant(s) states that the Office action (or notice) has not been received at the correspondence address of record, and the Office action (or notice) was mailed by Office between October 13, 2001 and January 2, 2002, then the evidence set forth in (B)(i) above would not be needed.

C) **Signature:** The petition must be signed by applicant(s) or a registered practitioner.

A separate petition must be filed for each application for which remailing of the action (or notice) and a restarted time period are requested. Each petition will be entered into the file wrapper as well as a decision notifying applicant(s) of the action by the Office. See Attachment II for a template decision granting petition to remail an Office action with a new period for reply. The decision may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record, but it must also be mailed to the correspondence address. When an Office action is remailed, the entire Office action must be remailed. For example, when a Notice of Allowance is remailed, a copy of the notice of allowability and attachments including interview summary form and examiner's amendment must also be remailed with the notice of allowance.

When remailing an Office action (or notice), the Technology Centers **will not** change the date of mailing of the original Office action (or notice). Instead, the Technology Centers will follow the procedure in Attachment IV, section II. A courtesy copy of the Office action (or notice) may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record.

Advisory Actions: A petition for remailing of an advisory action with restarting of a reply should be dismissed because the period for reply is set forth in the final Office action, and not in the advisory action. The delay in receipt of an advisory action does not necessitate the restarting

of the reply period set in the final Office action. A courtesy copy of the advisory action may be provided. In the circumstance where the advisory action relates to an after-final reply filed within two months of the final rejection and receipt of the advisory action was delayed, please contact an advisor in the Office of Patent Legal Administration at (703) 308-6906.

C. If Remailing with Restarting of Reply Period is Requested, and the Maximum Extendable Period for Reply has Expired (i.e., the application is abandoned):

If the maximum extendable period for reply has expired and a reply was not timely filed, the application is abandoned. The request for remailing and restarting of the reply period will be treated as a petition to withdraw the holding of abandonment because the Office communication was not received by the applicant. If the holding of abandonment is reflected in the record by a Notice of Abandonment, then the request should be treated by the Office that mailed the Notice of Abandonment. Otherwise, if a Notice of Abandonment has not been mailed, the Office that mailed the correspondence (e.g., the Notice of Allowance) should treat the request. The applicant(s) may, alternatively, file a petition to withdraw the holding of abandonment as provided in MPEP 711.03(c)(II), subsection (II), page 700-140, left-hand column (August 2001). If the Office correspondence, that applicant(s) has not received which led to abandonment, was mailed between October 13, 2001 and January 2, 2002, then applicant(s) should submit a clear statement that the Office communication was not received, and may submit a statement as set forth in (B)ii or (B)iii of section II B above, instead of filing the required evidence. Thus, in such situation, the applicant(s) will not be required to file a copy of the docket record or a copy of any other evidence where the correspondence would have been recorded. For example: if a *pro se* applicant(s) states that the Office action (or notice) has not been received at the correspondence address of record, and the Office action (or notice) was mailed by Office between October 13, 2001 and January 2, 2002, further the evidence would not be needed and such statement made by a *pro se* applicant is sufficient. See Attachment III for a template decision granting a petition to withdraw holding of abandonment. The decision may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record, but it must also be mailed to the correspondence address.

When remailing an Office action (or notice) after granting such a petition to withdraw the holding of abandonment, the Technology Centers **will not** change the date of mailing of the original Office action (or notice). Instead, the Technology Centers will follow the procedure in Attachment IV, section III. A courtesy copy of the Office action (or notice) may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record.

Further Information or Assistance: Questions concerning this memorandum should be directed to the Office of Patent Legal Administration at 308-6906 or e-mailed to Patent Practice.

Attachments:

- I: Template Decision for Granting Petition to Reset Period for Reply
- II: Template Decision for Granting Petition to Remail an Office Action and Restart Period for Reply
- III: Template Decision for Granting Petition to Withdraw Holding of Abandonment
- IV: PALM Procedures for Resetting and Restarting Reply Period

Note: when using a template decision for an application, please delete the attachment heading on the top.